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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,725	02/04/2004	Christophe Alain Thureau	00537-178003	4960
26161	7590	10/05/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			TUCKER, ZACHARY C	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,725

Applicant(s)

THURIEAU ET AL.

Examiner

Zachary C. Tucker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 and 10-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9Sep04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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***Response to Amendment***

As requested in the correspondence from applicants, filed 13 July 2005 (hereinafter "present amendment"), which is in reply to the Office action mailed 13 January 2005 (hereinafter "previous Office action"), claim 1 and the abstract have been amended.

***Election/Restrictions***

Claims 2-8, 10 and 12-30 remain withdrawn from consideration as not being readable on the elected species.

Claims 31-43 remain withdrawn from consideration as being drawn to a nonelected invention.

The search for the elected invention, the compounds, was broadened in view of the amendment to claim 1, since said amendment overcame the previously-applied prior art rejections.

Prior art anticipating claim 1 was found, whereupon the search was stopped. Claim 1 has not been completely searched. This Office action is made final, pursuant to Markush practice explained in MPEP 803.02.

***Status of Double Patenting Rejection***

In the previous Office action, claim 1 was provisionally rejected under 35 U.S.C. 101 as being a duplicate of claim 1 of copending U.S. Patent Application 10/333,556. In view of the present amendment, the rejection is hereby withdrawn.

***Status of Claim Rejections - 35 USC § 112***

In the previous Office action, claims 1, 9 and 11 were rejected under 35 U.S.C. 112, first paragraph, for lack of a disclosure enabling the production of the full scope of all prodrugs of compounds according to those claims.

In view of the present amendment, which deletes "prodrugs thereof" from claim 1, the rejection is hereby withdrawn.

Also in the previous Office action, claims 1, 9 and 11 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness of "prodrugs thereof," "C<sub>0</sub> alkyl" and for recitation of "when R<sup>5</sup> is H" in proviso (c) of claim 1.

In view of the present amendment, which deletes "prodrugs thereof," "C<sub>0</sub> alkyl" and the instance where R<sup>5</sup> is H from proviso (c), the rejection is hereby withdrawn.

***Status of Claim Rejections - 35 USC § 102***

In the previous Office action, claim 1 was rejected under 35 U.S.C. 102(a) and (e) as being anticipated by US 5,733,882 (Carr et al).

In view of the present amendment to claim 1, which requires there to be at least one -CH<sub>2</sub>- group in R<sup>3</sup>, the rejection is hereby withdrawn.

In the previous Office action, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by FR 2.132.632 (Bornowski and Herzig).

In view of the present amendment to claim 1, which requires there to be at least one -CH<sub>2</sub>- group in R<sup>3</sup>, the rejection is hereby withdrawn.

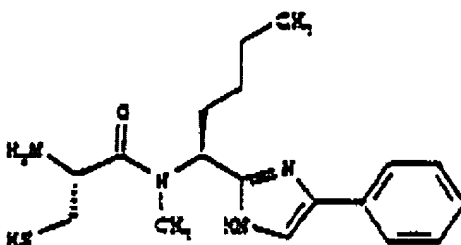
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### ***New Claim Rejection - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/30053 (Gordon et al). The reference is cited in the Information Disclosure Statement filed 9 September 2004.

At page 12 of Gordon et al is disclosed a compound, dubbed "Compound 8," having this structure –



This compound is embraced by instant claim 1 where R<sup>1</sup> and R<sup>6</sup> are H; R<sup>2</sup> is alkyl; R<sup>3</sup> is  $-(CH_2)_m-E-(CH_2)_m-Z^2$ , wherein the one "m" is 2 and the other "m" is also 2, "E" is a bond, and Z<sup>2</sup> is H; R<sup>4</sup> is  $-C(=Y)-X^2$  wherein Y is oxygen and X<sup>2</sup> is substituted alkyl.

## New Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-21 copending U.S. Patent Application No. 10/333,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-21 of the copending application anticipate compounds according to instant claim 1.

Applicants' arguments traversing the Statutory Double Patenting rejection over the co-pending application states that since the claims are no longer letter-for-letter duplicates of one another, then the rejection should be withdrawn. The only difference between instant claim 1 and claim 1 of the copending application now is that at least one  $m$  in  $R^3$  is required to be an integer from 1 to 6. This limitation is not in claim 1 of the copending application.

Claims 2-21 of the copending application, however, are all drawn to compounds wherein at least one  $m$  in  $R^3$  is an integer from 1 to 6.

#### ***Abstract of the Disclosure***

In the previous Office action, the abstract of the disclosure was objected to because no generic structure of the compounds according to the invention was provided, though "compounds of formula (I) are referred to in the abstract." In view of the present amendment to the abstract, the objection thereto is withdrawn.

***Information Disclosure Statement***

The items submitted 3 February 2005, and indicated in the previous Office action as not being in the file, have now been considered. A PTO-1449 form signed by the examiner, with these items initialed, everything else (previously considered by the examiner) lined through, is enclosed.

One cited reference, Hungarian patent HU218 460 B, item "D," is was not part of the submission of 3 February 2005, and remains missing from the file. This reference has not been considered.

***Allowable Subject Matter***

Claims 9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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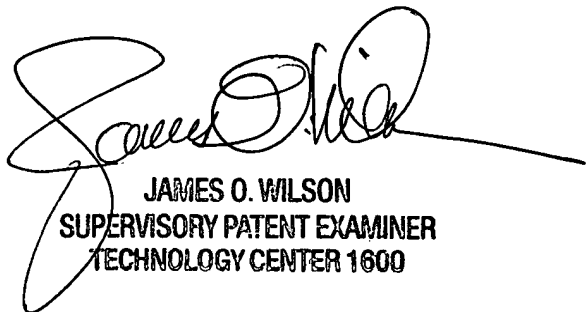
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Tuesday-Thursday from 8:00am to 4:30pm or Monday from 6:00am to 1:30pm. If Attempts to reach the examiner are unsuccessful, contact the examiner's supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

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**JAMES O. WILSON**  
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